

Attorney Docket Number: FSP0291

Application Number: 09/759,935

RECEIVED  
CENTRAL FAX CENTER

NOV 17 2006

-7-

**REMARKS**

The above-referenced patent application is subject of an Appeal filed 05/16/2006. A Reply Brief mailed on 08/28/2006 raised new grounds of rejection not set forth in the last office action, from which appeal was taken. In particular, the Reply Brief raised as a grounds of rejection the issue of whether the "adapted to" language of the claims limits the apparatus claims to a particular structure. The applicant addresses the matter herein. Furthermore, the applicant had amended the claims to better specify the distinctions over the cited references.

One point of contention is the meaning of the term "broadcast". The Applicant never misused this term, as the Reply Brief suggests. The claims clearly stated that the communication was broadcast to a group, which is in no sense a contradiction in terms. Clearly, this means that within the group, the communication was provided in broadcast fashion, e.g. not addressed to a particular terminal of the group and available to be read by any terminal of the group. In any case, the present claims are drafted to hopefully remove any further contention of this point.

**Use of "Adapted to" in Claims is not Per Se Non-Structural**

Use of "adapted to" is one example of claim language that may raise a question under PTO examination guidelines as to the limiting effect of the language in an apparatus claim ("whereby" clauses are another). See MPEP 2111.04. The determination of whether "adapted to" language recites a structural limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a "'whereby' clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention."

The same reasoning applies to "adapted to" limitations. Such limitations are not per se non-structural. Rather, the Examiner must look at whether they place a material

Attorney Docket Number: FSP0291

Application Number: 09/759,935

-8-

limitation on the structure of the device, that is material to patentability. It is, as always, the Examiner's responsibility to demonstrate why the "adapted to" limitation is non-distinguishing in a structural sense. In the Reply Brief, a summary assertion is made that the "adapted to" limitations are non-limiting because they are functional, but the Examiner provides no basis for why this is so.

In fact, a head-end, video server, or other digital device or system "adapted to" carry out certain acts is certainly distinguishable from a system not so adapted. This is so because under the PTO's own examination guidelines, as well as established case law, a device may be so adapted by incorporating in it a unique arrangement of logic in the form of software and/or hardware circuits. Incorporating such logic imparts sufficiently distinguishing structure to a digital memory or other electronic device. Thus, a device "adapted to" perform specific processing is indeed structurally distinct from other such devices that are not so adapted, because the adaptations necessary to carry out the processing impart structural distinction, even if such adaptations (such as software, circuits, or logic) are not explicitly recited.

Furthermore, as the Examiner is no doubt aware, it is notoriously difficult to claim arrangements of logic for carrying out unique processing features in digital systems, in a manner that avoids trivial design-arounds that merely re-arrange said logic, without resort to "adapted to" or equivalent claim constructs.

In summary, it is the Examiner's responsibility to positively argue why a headend, video server, or other device adapted to carry out the specific processing features recited in the claims is structurally identical to a device not adapted to carry out such processing. The Examiner cannot merely ignore the recited claim features because they are presented as an adaptation, and bears the responsibility of demonstrating that the headends of Rackman or Suzuki are also adapted to carry out the processing features (e.g. incorporating the structure imparted by similar software or other logic) recited in the claims, and are thus structurally equivalent.

Attorney Docket Number: FSP0291

Application Number: 09/759,935

-9-

**The Group Identifier Is Provided in a Communication to All Terminals of the Group**

Claim 22 recites a headend adapted to address a communication comprising an identification of a group of subscriber terminals to all terminals of the group.

Claim 22 recites that the communication of the identification of the group is not addressed to any one particular terminal of the group, and the identification of the group may be accessed and read by all terminals of the group.

Claims 26, 30, and 32 recite similar features.

In Rackman the communications are addressed to individual terminals, not to all terminals of the group. In Rackman, the communication of the full terminal address (which the Examiner asserts comprises a group identifier) is addressed to one particular terminal of the group. In Rackman, the identification of the group cannot be accessed and read by all terminals of the group from a particular communication, because the communication is always addressed to a particular terminal, not to all terminals of the group.

Thus, Rackman clearly does not teach the features recited in the claims.

**Dependent Claims Also Distinct**

The dependent claims also recite unique features not taught or suggested by any of the cited references.

For example, claim 24 recites that the group identifier is periodically communicated to the group of subscribers as part of a program stream.

Claim 27 recites that the application server and video server cooperate to stream the video on demand data to all subscriber terminals associated with the group identifier, and to enable a particular subscriber terminal that provided the request to view the video on demand data by informing the particular subscriber terminal of a program slot associated with the video on demand data.

Claim 28 recites that the video server periodically communicates as part of a program stream the subscriber group identifier to subscriber terminals associated with the

RECEIVED  
CENTRAL FAX CENTER  
NOV 17 2006

Attorney Docket Number: FSP0291

Application Number: 09/759,935

-10-

group identifier, and communicates the program slot to the particular subscriber terminal out of band.

None of these features are taught by the cited references.

**Conclusion**

For at least the reasons provided, all of the claims are distinguished over the cited references and should be allowed. If an interview would help further the prosecution, the Examiner is urged to contact the Applicant at the numbers provided below.

Respectfully Submitted by:

Signature      /Charles A. Mirho/  
Charles A. Mirho  
Reg. 41,199  
Attorney for Applicant

Date: 5/9/2006

Address all correspondence to:

FSP LLC

Attn: Charles A Mirho

P.O. Box 890

Vancouver, WA 98666-0890

USA

Phone: 360-737-1748

Fax: 360-294-6426